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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,857	11/14/2003	Masaaki Shimokawa	89155.0002	1887

26021 7590 10/30/2006

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT PAPER NUMBER

1722

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/713,857

Applicant(s)

SHIMOKAWA ET AL.

Examiner

Donald Heckenberg

Art Unit

1722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached page. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 4-6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

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1. The proposed amendment filed 17 October 2006 after a final rejection will not be entered because the amendment raises new issues that would require further consideration.

The amendment defines the mold structures as being "configured for forming" the features of the product that are molded by the process. To this end, Applicant argues in the remarks filed with the amendment that the features of the molded product are "indirectly afforded patentable weight." Response, p. 5, ll. 15 and 16.

The patentability of an apparatus is determined by the structure of the apparatus itself, not the product made by the apparatus or the method by which the apparatus is operated. See e.g. Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (noting apparatus claims cover what a device is, not what a device does). Thus, the patentability of the claimed mold core apparatus is determined by the actual mold structure.

The extent that the proposed amendment defines the claimed apparatus's structure is not immediately clear. For example, the exact foam-molded material used with the mold is not defined, and further the use of particular foams itself still only relates to the potential use for the mold. JP '134 and Chun would still render obvious the claimed mold if they could

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be used with some material that, because of the material's properties, resulted in a product not having any dimpled portions. A viscous, long-chained polymer material, for example, molded using the structure of the combination of JP '134 and Chun may be of such a nature as not to be able to enter small indentations on the mold surface, and thus not form a dimpled product. For these reasons, significant further consideration is going to be required to determine (1) the extent that the claimed core mold is actually limited by the claim's recitation in terms of the product molded by the claim, and (2) if indeed the claim is still not rendered obvious by the prior art. The amendment at this stage, after final rejection, will therefore not be entered.

Applicant's arguments filed with the amendment have been noted, but not found persuasive. The arguments relating to the core mold according to the proposed amendment are moot as the amendment will not be entered.

Applicant also argues that JP '134 discloses a steam path on the concave portion of the concavo-convex pattern, whereas the present invention restricts disposition of the steam path onto the convex portion of the concavo-convex pattern that is formed on the surface of the core mold.

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It is not seen where JP '134 requires a steam path on the concave portion of the mold. Figures 3 and 4 of the reference show steam paths (5) only provided on the convex portions of the mold. Further, as described more fully in the last Office action, the claims of the instant application do not preclude the placement of the steam path in the concave portions of the mold.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



10-27-6

Donald Heckenberg
Primary Examiner
A.U. 1722